

REMARKS

Claims 1-21 and 23 are all the claims presently pending in the application. Claims 1, 8, 12, 15-16, and 23 are amended to more clearly define the invention. Claims 4-14 have been withdrawn from prosecution. Claims 1, 4, 11, and 15 are independent.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Applicants gratefully acknowledge the Examiner's indication that claim 23 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicants respectfully submit that all of the claims are allowable.

Claims 1-3 and 15-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Applicants' admitted prior art.

This rejection is respectfully traversed in the following discussion.

I. THE RESTRICTION REQUIREMENT

The Office Action withdraws claims 4-14 from prosecution as allegedly being directed to inventions which are independent or distinct from the invention which was originally claimed.

Applicants respectfully traverse this restriction requirement.

The Examiner completely ignores one of the two requirements that the Examiner is

AMENDMENTS TO THE DRAWINGS

This Amendment encloses replacement drawing sheets which correct Figures 1-6 to include the legend "Prior Art."

Attachments: Replacements Sheets

Annotated Sheets Showing Changes

required to meet before a restriction may be issued. In this instance, the Examiner has completely failed to allege that the search for claims 4-14 is a serious burden on the Examiner. Therefore, the Examiner has failed to present a prima facie case for a restriction requirement.

M.P.E.P. § 803 clearly states that:

"if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions" (emphasis added).

Applicants respectfully submit that the Examiner has clearly failed to provide a prima facie showing of a serious burden by failing to provide:

"by appropriate explanation of separate classification, or separate status in the art, or a different field of search" (M.P.E.P. § 803).

Applicants respectfully submit that the subject matter of all claims 1-21 and 23 is sufficiently related that a thorough search for the subject matter of any one group of claims would necessarily encompass a search for the subject matter of the remaining claims. Thus, Applicants respectfully submit that the search and examination of the entire application could be performed without serious burden.

Applicants respectfully submit that the policy requiring examination of an entire application even though the Examiner alleges that it may include distinct inventions, should be applied in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office. Applicants respectfully request reconsideration and withdrawal of the restriction requirement and to examine all claims in

this application.

Applicants respectfully request withdrawal of the restriction requirement and/or rejoinder of claims 4-14.

II. THE CLAIMED INVENTION

An exemplary embodiment of the claimed invention is directed to a box nailing machine that includes a box nailing machine body including a nail driving port from which nails are driven, a handle portion with a handle arm, and a magazine for accommodating nails. A forward end portion of the magazine is attached to the nail driving port. A portion of the magazine except for the forward end portion is attached to the handle portion via the handle arm. The magazine includes a handle arm attaching portion for attaching the magazine to the handle arm. The magazine is made of metal and is formed substantially into a U-shape by press forming. The magazine also includes a plate integrally formed in the handle arm attaching portion so that the plate is disposed between a head portion of a fixing bolt and the magazine. The plate is fixed to the handle arm attaching portion by at least one of caulking, welding, soldering, and adhering.

Conventional box nailing machines that include a U-shaped metallic magazine have either fixed the magazine directly to a handle arm or attached the magazine using a plurality of bolts.

The conventional box nailing machines that fixed the magazine directly to the handle arm required replacement of the magazine even when only the handle arm was broken.

The conventional box nailing machines that attached the magazine to the handle arm using a plurality of bolts required either a plurality of washers that made assembly difficult or

a plate washer that required a large opening in a side of the magazine that reduced the strength of the magazine.

In stark contrast, an exemplary embodiment of the present invention provides a box nailing machine with a plate that is fixed to a handle arm attaching portion by at least one of caulking, welding, soldering, and adhering. In this manner, assembly of the magazine to a box nailing machine is greatly simplified.

III. THE PRIOR ART REJECTION

The Examiner alleges that Applicants' Admitted Prior Art teaches the claimed invention. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by Applicants' Admitted Prior Art.

Applicants' Admitted Prior Art does not teach or suggest the features of the independent claims including a box nailing machine that provides a plate that is fixed to a handle arm attaching portion by at least one of caulking, welding, soldering, and adhering.

Rather, and in stark contrast Applicants' Admitted Prior Art discloses a plate 10 that is fixed to the handle arm attaching portion by bolts.

Indeed, as explained above, Applicants' Admitted Prior Art suffers from exactly the same problem that the present invention solves.

Applicants' Admitted Prior Art discloses box nailing machines that include a U-shaped metallic magazine which have fixed the magazine directly to a handle arm using a plurality of bolts.

The conventional box nailing machines disclosed by Applicants' Admitted Prior Art fixed the magazine to the handle arm using a plurality of bolts. This required either a

plurality of washers that made assembly difficult or a plate washer that required a large opening in a side of the magazine that reduced the strength of the magazine.

In stark contrast, the claimed invention provides a a plate that is fixed to a handle arm attaching portion by at least one of caulking, welding, soldering, and adhering. In this manner, assembly of the magazine to a box nailing machine is greatly simplified.

The Examiner alleges “With regard to claim 22, Applicant’s (sic) Admitted Prior Art shows washer (9) fixed to the inner wall by at least one of caulking, welding, soldering, and adhering (see fig. 5).”

However, contrary to the Examiner’s allegation Applicants’ Admitted Prior Art does not teach or suggest this feature of the claimed invention.

Rather, as explained above, Applicants’ Admitted Prior Art discloses fixing the washers 9 and/or plate 10 to the handle arm attaching portion using bolts 7, not by by at least one of caulking, welding, soldering, and adhering.

Therefore, Applicants’ Admitted Prior Art does not teach or suggest each and every element of the claimed invention and the Examiner is respectfully requested to withdraw this rejection of claims 1-3, and 15-22.

IV. FORMAL MATTERS AND CONCLUSION

The Office Action objects to the drawings. This Amendment encloses replacement drawing sheets which correct Figures 1-6 to include the legend “Prior Art.”

The Examiner alleges that Figure 7 illustrates “Prior Art.” However, contrary to the Examiner’s allegation, as explained at, for example, page 2, lines 23-24, Figure 7 illustrates that the use of one plate was considered by the inventors. However, this embodiment was not

publicly known and/or disclosed. Applicants respectfully request withdrawal of this objection.

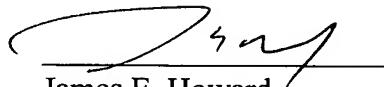
In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1-21, and 23, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 6/8/25

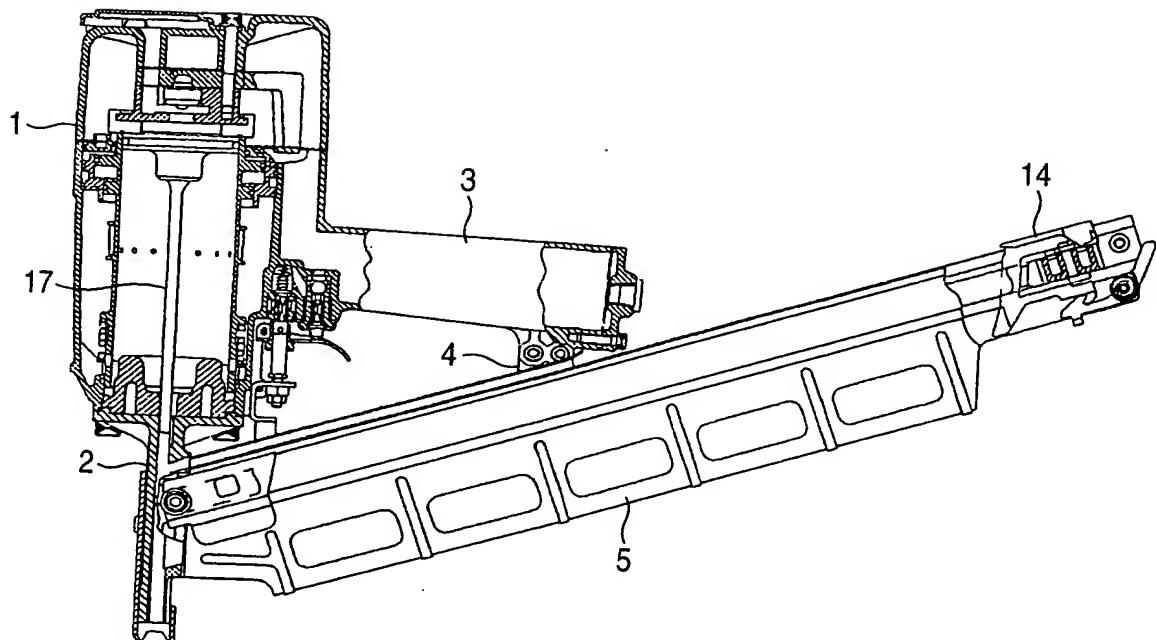


James E. Howard
Registration No. 39,715

McGinn & Gibb, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254

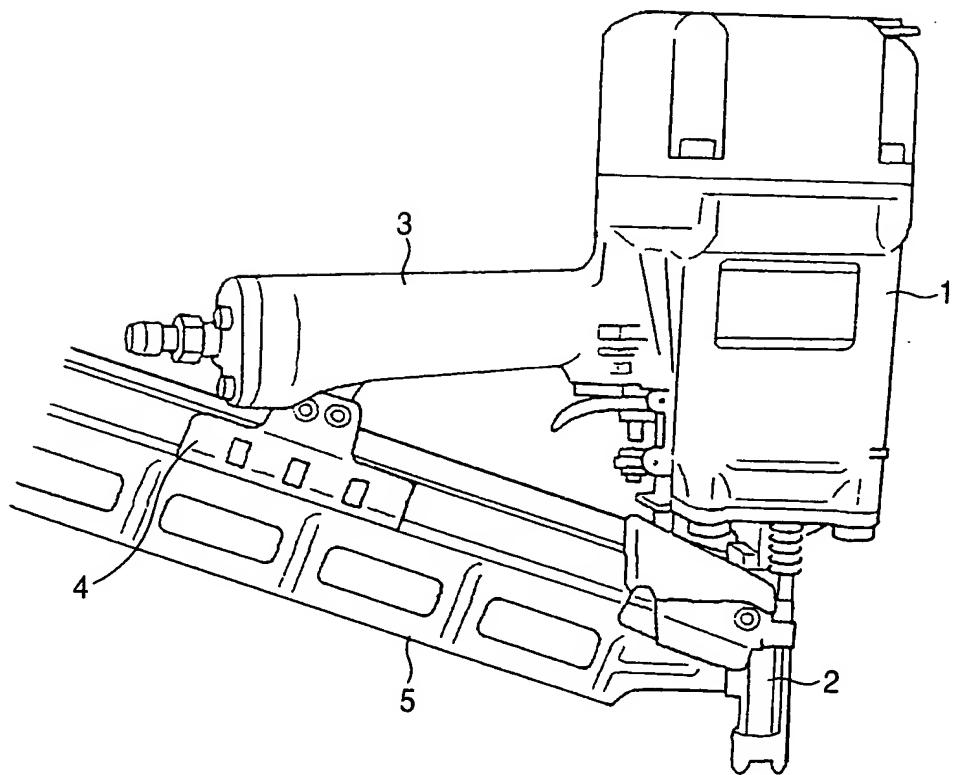
U.S. Patent Application Serial No. 10/697,009
Art Unit No. 3721
Annotated Sheet Showing Changes

FIG. 1 PRIOR ART



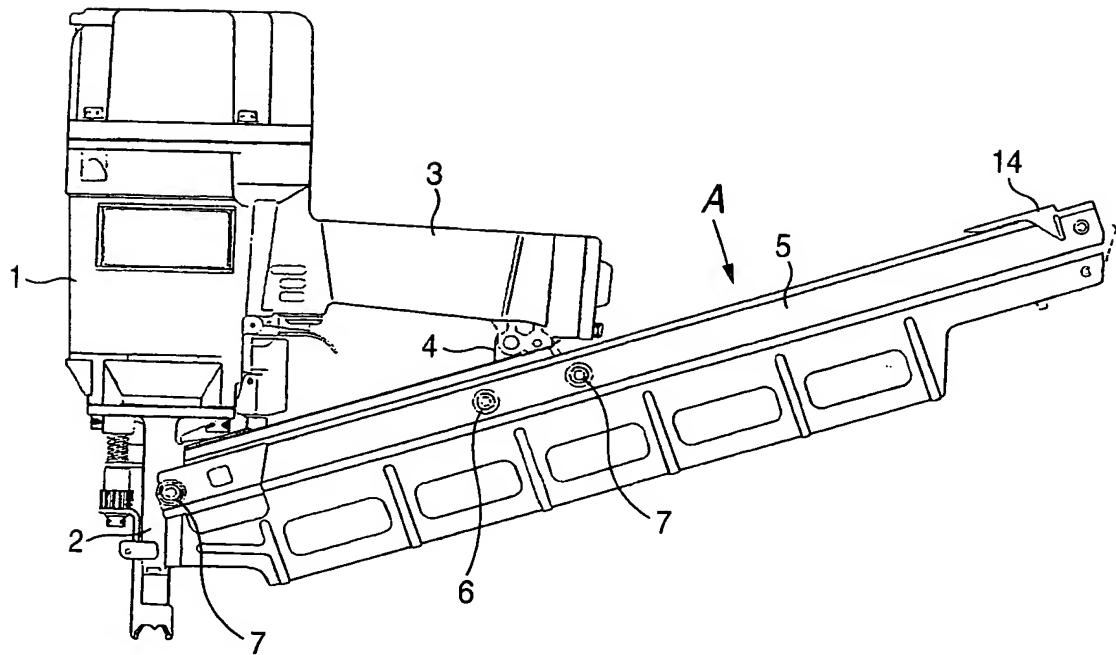
U.S. Patent Application Serial No. 10/697,009
Art Unit No. 3721
Annotated Sheet Showing Changes

FIG. 2 PRIOR ART



U.S. Patent Application Serial No. 10/697,009
Art Unit No. 3721
Annotated Sheet Showing Changes

FIG. 3 PRIOR ART



4/9

FIG. 4 PRIOR ART

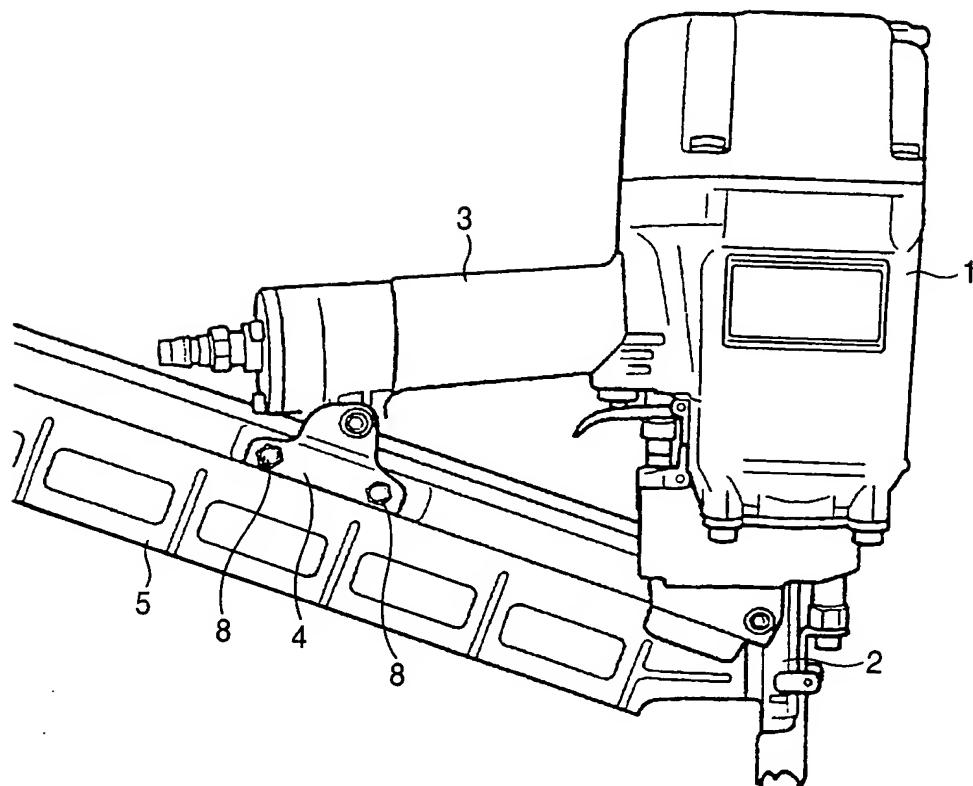
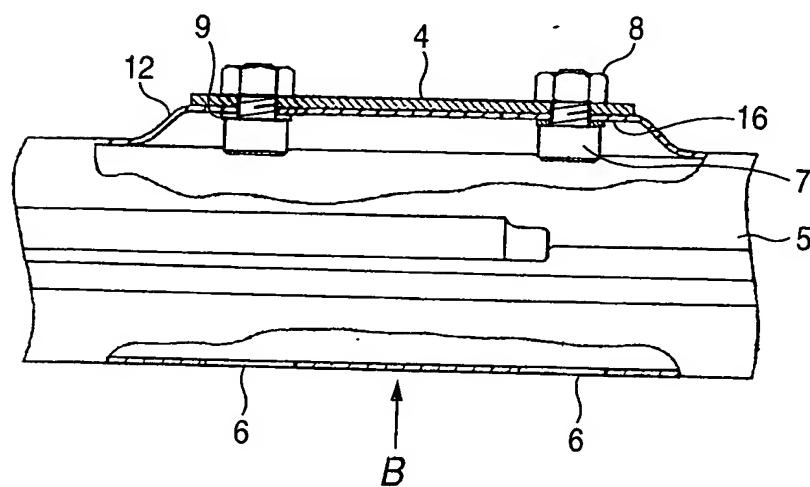


FIG. 5 PRIOR ART



U.S. Patent Application Serial No. 10/697,009
Art Unit No. 3721
Annotated Sheet Showing Changes

FIG. 6 PRIOR ART

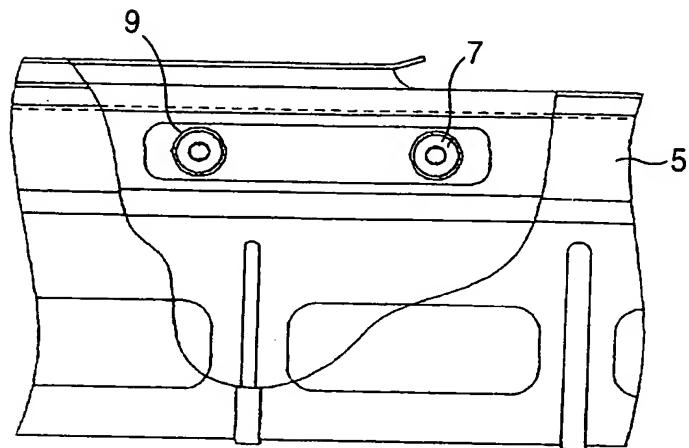


FIG. 7

